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EXAMINER	
POLLOCK, GREGORY A	

ART UNIT	PAPER NUMBER
3695	

NOTIFICATION DATE	DELIVERY MODE
09/30/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents@chadbourne.com

Office Action Summary	Application No.	Applicant(s)	
	09/942,453	JESSOP ET AL.	
	Examiner	Art Unit	
	GREG POLLOCK	3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15-19,23,34,45 and 47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13, 15-19, 23, 34, 45, and 47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to claims filed 08/02/2010 and Applicant's request for reconsideration of application 09/942453 filed 08/02/2010.

The amendment contains original claims 2-4, 6-12, and 15-19.

The amendment contains previously presented claims 5, 13, 23, 34, and 45.

The amendment contains amended claims 1 and 47.

Claims 14, 20-22, 24-33, 35-44, and 46 have been canceled.

As such, claims 1-13, 15-19, 23, 34, 45, and 47 have been examined with this office action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-13, 15-19, 23, 34, 45, and 47** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward the statutory category of a method (process), however based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a statutory § 101 process must (1) be tied to a particular machine or apparatus or (2) physically transform underlying subject matter (such as an article or materials) to a different state or thing. (i.e. "machine-or transformation test"). If neither of these requirements is met by the

claim, method is not a patent eligible process under § 101 and is rejected as being directed toward non-statutory subject matter.

There are two corollaries to the machine-or-transformation test. First, a mere field -of-use limitation in the preamble is insufficient to render an otherwise ineligible method claim patent-eligible. The machine or transformation must impose meaningful limits on the method claims scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. Therefore, reciting a specific machine or a particular transformation of a specific article is an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

As example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter being transformed, for example by identifying the material being changed to a different state. (Diamond v. Diehr, 450 US 175, 184 (1981); Parker V. Flook, 437 US 584,588 n.9 (1978); gottschalk v. Benson, 409 US 63, 70 (1972); Cochrane v Deener, 94 US 780, 787-88 (1876)). Applicant is also directed to MPEP § 2173.05p, providing guidance with respect to reciting a product and process in the same claim and MPEP § 2111.02 [R3] providing guidance with respect to the effect of limitations within the preamble of a claim.

In reference to claims, the claims do not positively recite the other statutory class (thing or product) to which it is tied, by identifying the apparatus that accomplishes the method steps. First, the claims have been amended to include the phrase “via a processor”. Webster's New World College Dictionary, 4th Ed. defines the term “via” as “by means of”. As such the claim limit “selecting via a processor a first corporate entity information type that defines a first corporate entity;” becomes “selecting by means of a processor a first corporate entity information type that defines a first corporate entity;”. A broad and reasonable interpretation of the claim limit is that a processor is used, but that the action of

the claim limit (selecting) can be interpreted as a human using a computer (processor). Even if the phrase "via a processor" is interpreted as the processor performing the action, based on the applicant's arguments this does not appear to be a core/central part of what the applicant invented. Additionally, claim 1 includes the nominal recitations of a "processor-implemented" method. However the remaining limits of claim 1 do not recite what structural apparatus is performing the method steps. Therefore, it is unclear what is performing these method steps and as such it is broadly interpreted to encompass all means by which the claim limit can be performed (including a purely mental step performed by a human). To resolve this deficiency, it must be made clear what underlying apparatus is used to perform each recited method step, particularly those that are considered a core/central part of what the applicant invented. **Additionally, merely stating the underlying apparatus in the preamble is not sufficient**. Further, if the method step is performed by software, it must be made clear that the software resides on a physical media and when read by a processor executes the method steps (all of which requires support in the specification). It is recommended that the claim be amended to clarify which method steps are performed by automatically by code and which required human decisions or action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-13, 15-19, 23, 34, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guheen et al. (U.S. Patent No. 6721713) in view of Feibush et al. (PGPub Document No. 20020158918) in further view of Rebane (U.S. Patent No. 6078904).

As per claim 1, Guheen et al. teaches **a processor-implemented method, comprising:**
selecting via a processor a first corporate entity information type that defines a first corporate entity ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14])**;**
selecting via a processor a second corporate entity information type that defines a second corporate entity ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14])**;**
selecting via a processor a corporate entity relationship information type that defines a relationship between said first and second corporate entity information types ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14])**;**
analyzing via a processor the selected information types ([Figures 1, 10, 11, 18, 27A-F, 29A] [columns 1-2] [columns 7-14])**;**
displaying via a processor, based on the analysis, said corporate entity identity and said corporate entity relationship information types in a graphical user interface view with predetermined indicia, the indicia graphically providing an indication of a connection between said first and second corporate entity information types ([Figures 1, 8, 10, 11, 16, 18, 23B, 27A-F, 29A] [columns 1-2] [columns 7-14])**;**
dynamically analyzing, via a processor, in coordination with said alternation mechanism, selected information types and providing via a processor an alteration mechanism to dynamically change an information type, chosen from the group comprising corporate entity, corporate entity relationship, selection, grouping, arrangement and view type to be

displayed in said graphical user interface view ([Figures 21C, 27A-F, 29A] [columns 1-2] [columns 7-14] [column 29]. Here the examiner notes that, although the entire claim limit is shown in the prior art, it is only required that "an alteration mechanism" be disclosed since the remainder of the claim limit "to dynamically change an information type, chosen from the group comprising corporate entity, corporate entity relationship, selection, grouping, arrangement and view type to be displayed in said graphical user interface view" is a statement of intended use.)

Guheen et al. discloses comparing of the strengths and weaknesses of each individual entity ([column 11]). However, Guheen et al. does not explicitly disclose **graphically providing an indication of a strength of the relationship or dynamically changing, via a processor, using said alteration mechanism, a displayed information type to a newly chosen information type; displaying, simultaneously, via a processor, based on the dynamic analysis, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types.**

However, Feibush et al. discloses **graphically providing an indication of a strength of the relationship and dynamically changing, using said alteration mechanism, a displayed information type to a newly chosen information type** ([Figures 5-7] [pages 1-4])**; displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types** ([Figures 4-7] [¶30-33] Here the examiner notes that, although the entire claim limit is shown in the prior art, it is only required that "displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface" be disclosed since the remainder of the claim limit "to facilitate a comparison regarding said first corporate entity and said second corporate entity information types" is a statement of intended use.).

It would be obvious to one of ordinary skill in the art at the time of the invention to adapt the use of comparison displays based on running scenarios for analysis, comparison and patterns regarding relationships between entities as disclosed by Feibush et al. with the method of pictorially displaying alliances among entities as disclosed by Guheen et al.. The motivation would be to use commonly known

techniques in the field of computer technology to provide multiple views within one screen to provide a means of making side-by- side visual comparisons.

Guheen et al. and Feibush et al. do not teach **generating via a processor at least one pattern between said first and said second corporate entity information types based on the comparison and the dynamic analysis; and constructing via a processor a financial product based on said selected and displayed information types and said generated at least one pattern.**

Rebane teaches *inter alia* that an account management module provides a user interface to one or more online investment systems, such as a brokerage house to access and update an investor's account. The account management module retrieves and displays securities data, corporate financials, market performance data and other research information. The account management module also provides for individual trades in the investor's accounts, and transfers the list of current buy/sell order to the investor's investment account for execution. The communications interface gateway provides an interface to external databases containing securities data, such as corporate financial data, industry performance, securities price and performance data, investment advisor opinions and consensus ratings, and the like, including, in some versions, more comprehensive portfolio management services without the portfolio analysis and optimization functions as provided by the present invention, as commonly available from brokerage houses, investment firms, and other sources. [column 11]. The investor specifies predicted future performance data for each investment asset. The future performance data may be the alpha, beta, sigma, R2, and cross correlations related to the Efficient Market Hypothesis approach or derived from any other predictive theory, including estimates that may by available in the securities database, information from investment advisors, or inputs which just reflect the investor's own assessments of the future performance of the investments. Regardless of the Market Hypothesis used, the short list maker module computes and updates a covariance matrix for the list [column 12, lines 39-59] (applicant's **generating via a processor at least one pattern between said first and said second corporate entity information types based on the comparison and the dynamic analysis.** Also see [Figure 10] [columns 17-18, Section 5.4.4 Correlation Matrix]). Rebane further teach **; and constructing via a processor a financial product based on said selected and displayed information types and said generated at least one pattern** ([Title] [Abstract] [column 12, lines 28-46]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the invention of Rebane with that of Guheen et al. and Feibush et al. to achieve the claimed invention. Guheen et al. provides a system and method for identifying alliances among a plurality of business entities in components of a network framework [Abstract], which can be combined with

Feibush et al. to depict a more detailed flow diagram showing data representing objects, events, and correlations that are classified to produce a taxonomy. Each object being a tangible entity that occupies a physical location or region in space and has a state with multiple attributes associated therewith, where each object can stand alone without any link to other entities in the correlation graph. [¶19]. The graphical correlation data of Feibush et al. is stored [Abstract] [¶7] such that the invention Rebane could retrieve and use such data as part of its user interface when constructing and optimizing an investment portfolio. Therefore, since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Indeed, any number of prior art references can be combined with Guheen et al. and Feibush et al. to construct a portfolio from the performance data (applicant's patterns and/or critical path) to accomplish the claimed invention. The examiner has listed a few other examples of prior art made of record and not relied upon in the Conclusion section of this office action which could also be used to generate a portfolio using data acquired from the interface of the combined inventions of Guheen et al. and Feibush et al.

As per claims 2-13, the rejection of claim 1 has been addressed.
Guheen et al. teaches **predetermined corporate entity information chosen from the group comprising corporate entities and corporate information; the group comprising buyer-seller relationships, customer-supplier relationships, company-client relationships, parent company-subsidiary relationships, ownership relationships, resource sharing relationships, joint ventures, political/business relationships, competitor relationships, value chain relationships, horizontal and vertical relationships; selection and grouping information chosen from the group comprising stocks, bonds, financial instruments, sectors, industry segments, SIC codes, and product lines; arrangement information chosen from the group comprising column, row, grid, map, free-form, and structured; view type information chosen from the group comprising fundamental information, market risk information and performance information** ([Figures 1, 8, 10, 11, 14, 16, 17, 18, 21C-F, 23B-F, 27A-F] [columns 1-2] [columns 7-14]).

As per claims 15-19, the rejection of claim 1 has been addressed.
Guheen et al. teaches **corporate entity and corporate relationship indicia are chosen from the group comprising graphic, audio, video; graphic and corporate entity relationship indicia chosen from the group comprising color, pattern and shape** ([Figure 1, 11, 16, 22, 27A- F, 94] [columns 1-2] [columns 7-14]).

As per claim 23, the rejection of claim 1 has been addressed.

Guheen et al. teaches that **alteration mechanism is chosen from the group comprising pointing device input, keyboard input and voice input** ([column 23]).

As per claim 34, the rejection of claim 1 has been addressed.
Guheen et al. and Feibush et al. do not teach a method **wherein the financial product is chosen from the group comprising market baskets of financial instruments, structured products, financial indices and mutual funds.**

Rebane teaches a method **wherein the financial product is chosen from the group comprising market baskets of financial instruments, structured products, financial indices and mutual funds** ([column 8, lines 6-23]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the invention of Rebane with that of Guheen et al. and Feibush et al. to achieve the claimed invention. Guheen et al. provides a system and method for identifying alliances among a plurality of business entities in components of a network framework [Abstract], which can be combined with Feibush et al. to depict a more detailed flow diagram showing data representing objects, events, and correlations that are classified to produce a taxonomy. Each object being a tangible entity that occupies a physical location or region in space and has a state with multiple attributes associated therewith, where each object can stand alone without any link to other entities in the correlation graph. [¶19]. The graphical correlation data of Feibush et al. is stored [Abstract] [¶7] such that the invention Rebane could retrieve and use such data as part of its user interface when constructing and optimizing an investment portfolio. Therefore, since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 45, the rejection of claim 1 has been addressed.
Guheen et al. teaches **providing another information type, chosen from the group of government entities, government information, financial entities, financial information, industry information, industry segment information, sector information, index information, personal entities and personal information, that may be displayed in said graphical user interface view, selected by said alteration mechanism, and related to the other information types by said indicia** ([Figures 1, 8, 10, 11, 14, 16, 17, 18, 21C-F, 23B-F, 27A-F] [columns 1-2] [columns 7-14] [column 23]).

As per claim 47, All of the limits of Claim 47 have been previously addressed in Claims 1-13, and is therefore rejected using the same prior art and rationale.

Response to Arguments

6. Applicant's arguments with regards to claims 1-13, 15-19, 23, 34, 45, and 47, filed 08/02/2010 have been fully considered but they are not persuasive.

7. APPLICANT REMARKS CONCERNING Claim Rejections - 35 USC § 101: The applicant contends that that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states "claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection." MPEP § 2106 also discusses "[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be." Applicants submit that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Although Applicants respectfully traverse the Examiner's rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicants have amended independent claims 1 and 47. Claims 1 and 47 recite, inter alia, "A processor- implemented method, comprising: ... displaying via a

processor ... providing, via the processor, ... dynamically changing, via the processor, ... "As such, Applicants submit claims 1 and 47 (and as a consequence, claims depending therefrom) are transformative and/or specific structures directed to statutory subject matter for at least the reasons discussed above.

8. EXAMINER'S RESPONSE: The examiner respectfully disagrees with the applicant's arguments. As stated in the Claim Rejections - 35 USC § 101 section of this office action, the claims do not positively recite the other statutory class (thing or product) to which it is tied, by identifying the apparatus that accomplishes the method steps. First, the claims have been amended to include the phrase "via a processor". Webster's New World College Dictionary, 4th Ed. defines the term "via" as "by means of". As such the claim limit "selecting via a processor a first corporate entity information type that defines a first corporate entity;" becomes "selecting by means of a processor a first corporate entity information type that defines a first corporate entity;". A broad and reasonable interpretation of the claim limit is that a processor is used, but that the action of the claim limit (selecting) can be interpreted as a human using a computer (processor). Even if the phrase "via a processor" is interpreted as the processor performing the action, based on the applicant's arguments this does not appear to be a core/central part of what the applicant invented. Additionally, claim 1 includes the nominal recitations of a "processor-implemented" method. However the remaining limits of claim 1 do not recite what structural apparatus is

performing the method steps. Therefore, it is unclear what is performing these method steps and as such it is broadly interpreted to encompass all means by which the claim limit can be performed (including a purely mental step performed by a human).

9. APPLICANT REMARKS (pages 15-19): The applicant contends that Applicants have amended claims 1 and 47 to include, "generating, via the processor, at least one pattern between the first and the second corporate entity information types based on the comparison and the dynamic analysis." As stated in the Office Action response filed, December 9, 9oo9, having provided a "short list" of "investment asset[s]" for risk evaluation, Rebane does not discuss any type of comparison in retrieving the "short list" or "covariance matrix." Nor does Rebane discuss "generating...at least one pattern .... " As such, Applicants submit Rebane's short list and covariance matrix are different from the claimed, "generating, via the processor, at least one pattern between the first and the second corporate entity information types based on the comparison and the dynamic analysis," as recited in independent claims 1 and 47.

10. EXAMINER'S RESPONSE: The examiner respectfully disagrees with the applicant's arguments. Figure 10 and its corresponding description found in columns 17-18, Section 5.4.4, show a screen display representing the correlation matrix. The examiner contents that Figure 10 shows a "generated pattern", and meets the claim limit (which is currently very broad). To overcome the prior art,

the examiner suggests further refinement in describing the form of the "generated pattern" .

11. Therefore, in view of the above reasons, Examiner maintains rejections.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pollock whose telephone number is 571 270-1465. The examiner can normally be reached on 7:30 AM - 4 PM, Mon-Fri Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chuck Kyle can be reached on 571 272-5233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GAP

09/17/2010

/Gregory Pollock/
Examiner, Art Unit 3695

Gregory A. Pollock

/Thu Thao Havan/
Primary Examiner, Art Unit 3695